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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. [redacted] 87

IN THE MATTER

of

The Application of HAROLD R. DALTON and AUSTIN G. COOLEY for United States Letters Patent.

HAROLD R. DALTON and AUSTIN G. COOLEY,
Petitioners,

vs.

JOHN A. MARZALL as Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

JOHN J. ROGAN,
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Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners pray that a writ of certiorari issue to review the judgment and the final order of the United States Court of Customs and Patent Appeals dated March 6, 1951 and April 10, 1951 respectively. A petition for rehearing, and/or modification, or remand (R. 102-121) was duly filed in the said Court, which petition was denied on April 10, 1951.

Opinions Below.

The majority opinion (R. 90-96), the specially concurring opinion (R. 96-98); and the dissenting opinion (R. 98-100).

Jurisdiction.

The jurisdiction of this Court is invoked under Title 28, Section 1256 United States Code.

A certified transcript of the record in the case including the proceedings in the United States Court of Customs and Patent Appeals in compliance with Rule 38, is filed herewith.

Questions Presented.

1. **Whether the Court of Customs and Patent Appeals can deny applicants for United States Letters Patent their rights to due process of law under the Constitution of the United States, Amendment 5, by refusing to consider all the evidence as required by Sec. 4914 R. S.; Title 35, Sec. 62 U. S. C., which evidence is certified to the Court by the Commissioner of Patents as a true record for the Court.**

2. **Whether the Court of Customs and Patent Appeals can, consonant with the Constitution of the United States, Amendment 5, refuse to remand an application for Letters Patent to the Patent Office, where the Court expressly refuses to consider all the evidence, notwithstanding such evidence is certified as part of the record to the Court by the Commissioner of Patents.**

3. **Whether the Court of Customs and Patent Appeals properly construes and applies the rules of law laid down by this Court in United Carbon Co., et al., v. Binney & Smith Co., 317 U. S. 228; Halliburton Oil Well Cementing Co. v. Walker et al., doing business as Dephograph Co., 329 U. S. 1.**

4. **Whether the Court of Customs and Patent Appeals can, against the evidence of record, modify a prior art disclosure with a teaching not suggested by, or necessary to the intended mode of operation of that disclosure, and after having seen the applicant's disclosure, and thus deprive an applicant of his right adequately to claim his invention.**

Statutes and Commissioner's "Notice" Involved.

The pertinent statutory provisions, and the respondent's Notice of January 4, 1950, are printed in Appendix "A", *infra*, and the Court is asked to take judicial notice thereof.

Statement.

An application (R. 1-19) for Letters Patent was duly filed by petitioners with the Commissioner of Patents and certain claims thereof were finally rejected by the Patent Office Examiner (R. 36). An appeal was lodged with the Board of Appeals which affirmed the Examiner (R. 44-46). The only prior art reference actually relied upon by the Examiner and the Board was a patent No. 2,188,590 (R. 73-77). Both the Examiner and the Board found that there was invention in petitioners' application by allowing claim 37 (R. 89). The gravamen of the final rejection was that the rejected claims do not patentably distinguish from the said patent No. 2,188,590, under the rule of law announced by this Court in *United Carbon* v. *Binney & Smith, supra.* In order to correct a false assumption made by the Board for the first time in the case, petitioners filed a petition for reconsideration and rehearing and included as an integral part of that petition, certain affidavits and documentary exhibits (R. 52-61) to show the true meaning of the disclosure of the reference and especially the non-conducting

or insulating characteristic of the "ordinary carbon paper" of the reference. The Board considered the petition and adhered to its prior ruling (R. 62), admitting that it could find "no statement or implication" in its prior decision that "carbon paper as mentioned in the reference patent, is electrically conductive."

An appeal was duly lodged in the Court of Customs and Patent Appeals together with the reasons of appeal (R. 63-65). The record before the Commissioner of Patents as certified by him to the Court (R. 2) included the said affidavits and documentary exhibits. The Court affirmed the Board and rendered three separate opinions, a majority opinion (R. 90-96), a specially concurring opinion (R. 96-98), and a dissenting opinion (R. 98-100). The Court refused to consider all the evidence certified to it by the Commissioner (R. 95).

The majority opinion fell in with the Board's erroneous reasoning that the "ordinary carbon paper" of the reference patent when made electrically conductive *in accordance with petitioners' teaching*, negatived invention in the rejected claims, and the majority ignored the actual limitations of the rejected claims as a unitary concept. The part of the record which was certified to the Court on that issue was given no consideration by the majority, notwithstanding the mandatory directions of Sec. 4914 R. S.; 35 U. S. C. Sec. 62.

The specially concurring opinion was based upon the provisions of a certain Rule 138 (R. 96) of the Patent Office which related to the procedure in filing affidavits "after the case has been appealed" from the Primary Examiner to the Board. The Court below has no such rule of procedure and its duties are defined by Sec. 4914 R. S.

The dissenting opinion reversed the Board both on the conclusion of fact and on the conclusion of law.

Within the time provided for by the Court rules, petitioners filed a petition for rehearing (R. 102-121) setting forth grounds upon which the petitioners believed the Court had clearly erred both on law and facts, and including "Ground VII" (R. 121) specifying a denial of petitioners' rights under the "due process" clause of Amendment 5 of the Constitution of the United States, and specifying a denial of their rights to a consideration of all the evidence (Sec. 4914 R. S.). Petitioners also requested that the proceedings be remanded to the Board with instructions to remand to the Examiner to consider all the evidence of record. The Court below refused to remand (R. 123).

Specification of Errors to Be Urged.

The Court of Customs and Patent Appeals erred:

1. **In refusing to consider all the record certified to it by the Commissioner, including the affidavits and their accompanying Exhibits (R. 52-61).**

2. **In refusing to remand the case to the Commissioner for consideration of the evidence which the Court refused to consider.**

3. **In misconstruing and misapplying to the finally rejected claims the rules of law as announced by this Court in United Carbon et al., v. Binney & Smith Co., 317 U. S. 228; Halliburton Oil Well Cementing Co., v. Walker et al., doing business as Depthograph Co., 329 U. S. 1.**

4. **In ruling that petitioners' claims merely differentiate from the reference patent No. 2,188,590 by a "functional" or "use" limitation, and by construing the elements of petitioners' claims piecemeal rather than as a unitary concept.**

5. In affirming the decision of the Board of Appeals and thereby finally refusing the petitioners adequate protection for their invention under the Constitution of the United States.

Reasons For Granting the Writ.

Preliminarily it should be noted petitioners raised the Constitutional issue of deprivation of "due process" in their petition for rehearing or remand (R. 121) based upon the Court's unexpected construction of 4914 R. S. (See *Brinkerhoff-Faris Trust* v. *Hill,* 281 U. S. 673; *Saunders* v. *Shaw,* 244 U. S. 317, 320).

Reason A. It is of great importance to future litigants before the Court of Customs and Patent Appeals and in the interest of proper administration of justice in that Court to know whether or not Title 28 Sec. 1256 U. S. Code, gives the right to have this Court review failures of justice in the Court of Customs and Patent Appeals arising either by that Court refusing to consider the entire record certified to it by the Commissioner of Patents, or by that Court misapplying or misconstruing the law with respect to a case or controversy before it.

Argument.

While the Court of Customs and Patent Appeals is a legislative Court rather than a Constitutional Court, to fulfill its statutory duties it must construe and apply the law as a judicial function, as well as acting as an administrative arm of the Patent Office. The statute (Sec. 4914 R. S.) requires it to

> "hear and determine * * * on the evidence produced before the commissioner. * * *"

Certainly, in construing and applying the rules of law announced by this Court, the Court of Customs and Patent Appeals (R. 94, 96, 98) acted in a judicial capacity on a justiciable issue. As stated by Mr. Chief Justice Hughes delivering the opinion of the Court in *Federal Radio Commission* v. *Nelson Bros., B. & M. Co.*, 289 U. S. 266 at 277:

> "A finding without substantial evidence to support it—an arbitrary or capricious finding—does violence to the law. It is without the sanction of the authority conferred. And an inquiry into the facts before the commission, in order to ascertain whether its findings are thus vitiated, belongs to the judicial province and does not trench upon, or involve the exercise of, administrative authority. * * * The controlling question is whether the function to be exercised by the court is a judicial function, and, if so, it may be exercised on an authorized appeal, from the decision of an administrative body. We must not 'be misled by a name, but look to the substance and intent of the proceeding.' "

The situation as here, involved, constitutes a case or controversy within Article III, Sec. 2, Clause 1 of the Constitution of the United States.

> "It is not important * * * whether such a proceeding was originally begun by an administrative or executive determination, if, when it comes to the Court, *whether legislative or constitutional,* it calls for the exercise of only the judicial power of the court upon which jurisdiction has been conferred by law (Old Colony Trust Co. *v.* Commissioner of Internal Revenue, 279 U. S. 716, at 722). (Emphasis supplied.)

The procedure in the United States Court of Customs and Patent Appeals pursuant to Sec. 4914 R. S., "contemplates a judicial judgment" to the same extent as was ruled by

this Court in *Federal Radio Commission* v. *Nelson Bros.*, and *Old Colony Trust Co.* v. *Commissioner of Internal Revenue, supra.* See also *Pope* v. *United States,* 323 U. S. 1, at 15, 16, and other cases cited therein.

The prior ruling of this Court in *Postum Cereal Co.* v. *California Fig Nut Co.,* 272 U. S. 693 is not controlling in the present matter because:

1. That case involved merely a *registration* cancellation right under a trade-mark registration statute. The present case involves a final denial of petitioners' constitutional right to a patent *grant,* and without due consideration by the Court below of all the evidence of record, and the Postum *v.* California Fig Nut case should be read in the light of Federal Radio Commission *v.* Nelson, 289 U. S. 266; Old Colony Trust *v.* Commissioner, 279 U. S. 716; Hoover *v.* Coe, 325 U. S. 79.

2. That case was decided Jan. 3, 1927 *before* the transfer of jurisdiction from the Court of Appeals of the District of Columbia to the Court of Customs and Patent Appeals (Act of March 2, 1929, Public No. 914, 70th Congress), and *before* the enactment of Sec. 1256, Title 28, U. S. C. At the time of the Postum *v.* California Fig Nut decision, the Court of Appeals, D. C., could not render a final judgment as to whether an applicant was entitled to any given claim or claims of his pending application for Letters Patent, since the defeated applicant in that Court could initiate proceedings *de novo* in the U. S. District Court, D. C., by equity suit against the Commissioner of Patents.

On March 2, 1927 the statute was revised (35 U. S. C. Sec. 59: R. S. 4911; c. 273, Sec. 8; 44 Stat. 1336) requiring an applicant to elect whether to proceed by way of appeal to Court of Appeals, D. C., or by way of equity suit against the Commissioner. On March 2, 1929 the statute was again revised, transferring the jurisdiction from the Court of Appeals, D. C., to the Court of Customs and Patent Appeals (c. 488, Sec. 2;

45 Stat. 1476). Therefore under the existing law, once an applicant has elected to proceed by way of appeal to the Court of Customs and Patent Appeals, the ruling of that Court adverse to his claim or claims is a final one. For the convenience of this Court Appendix "B" *infra*, graphically illustrates the remedies which an applicant had before and after the Postum *v.* California Fig Nut decision.

3. The ruling of the Board of Appeals and therefore a ruling of the Court of Customs and Patent Ap-Appeals is "neither a procedural one nor an interlocutory one * * * it finally denied a patent on the claims presented", and is in the nature of a dismissal. (Hoover *v.* Coe, 325 U. S. 79, 90, which was a case involving finality of a Patent Office rejection):

> "Thus it is clear that throughout more than a century Congress has for correction of erroneous rulings, which if unreversed would end the proceedings in the Patent Office, preserved the remedy by bill in a district court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal. (Hoover *v.* Coe, 325 U. S. 79, at 87, 88.)

4. The Commissioner of Patents who is the respondent here, treats the rulings of the Court of Customs and Patent Appeals as final. (See Commissioner's Notice of January 4, 1950, Vol. 630 Official Gazette United States Patent Office, page 617, which for the convenience of the Court is included in Appendix "B" *infra* and as to which this Court is respectfully asked to take judicial notice.)

5. As a matter of actual practice the Court of Customs and Patent Appeals acts on appeals from the Patent Office in a judicial rather than in an administrative manner.

Reason B. If this writ is not granted, the ruling of the Court below will be final on the petitioners' right to a patent on the rejected claims and notwithstanding that the Court below refused to consider all the evidence certified to it as regards the actual teaching of the reference patent, and has refused to remand to have that evidence considered.

Argument.

For the first time in the proceedings, the Board of Appeals injected the proposition that the reference patent No. 2,188,590 (R. 45) discloses a duplicating *coating* which "may be ordinary carbon paper." The record clearly shows that "ordinary carbon paper" is an insulator and does not have the physical characteristic of being "electrically conductive" which is a *sine qua non* of certain of the rejected claims, and as expressly set forth therein both by way of the preamble of the claim and by way of the claim element (See claim 25, R. 86). The reference patent is by reason of its own teaching entirely silent on that all-important physical characteristic. The Examiner never took the position that the reference patent discloses an electrically conductive carbon paper, and indeed he could not do so since there is nothing in that patent to indicate or even suggest that "ordinary carbon paper" has the property of electric conductivity. On reconsideration the Board surmised that since petitioners' composite dye-carbon duplicating coating is electrically conductive, then the "ordinary carbon paper" of the reference must also be electrically conductive. Neither the Board nor the Court had the right to refuse the petitioners' claims on the basis of information derived from the petitioners' own disclosure, and against the evidence of record.

The Patent Office Rule 138 which the concurring opinion below refers to (R. 96), has no application to the filing of affidavits *after* an appeal has been decided by the Board, but only to the filing of affidavits in the interim between the final rejection of the Examiner and before the Board has decided. The affidavits which the Court refused to consider were filed *as a result* of that Board for the first time surmising that the non-conductive "ordinary carbon paper" of the reference is structurally the same as petitioners' *composite* dye-carbon coating which is electrically conductive. The petitioners' had no way of knowing in advance, that the Board would make an erroneous assumption and thereby inject a new issue into the proceeding. The specially concurring opinon below ruled that since petitioners had not specifically referred to said affidavits in their reasons of appeal, the Court had no jurisdiction to consider them. The Board never stated that it had not considered the affidavits, and petitioners were entirely within their rights in believing that the Board had considered them. There is nothing in the record to support the Court's "guess" that the Board had not considered the affidavits. The record certified by the Commissioner to the Court speaks for itself and is binding as the record of evidence which the Court should have considered. Even if the Court had been ignoring such evidence in prior cases, that is no basis for it continuing the error. The doctrine of *stare decisis* is no justification for a Court voluntarily curtailing its own jurisdiction as set forth in the enabling Statute (35 U. S. C., Sec. 62; Sec. 4914 R. S.). Furthermore the petitioners' reasons of appeal (R. 63-65) were entirely adequate to support the Court's jurisdiction to consider the evidence certified to it by the Commissioner. The Court erroneously construed the Statute as if it read "on

the evidence considered by the Board of Appeals", whereas the Statute broadly states "on the evidence produced before the commissioner." The record certified by the commissioner contains the evidence which the Court refused to consider.

Reason C. The Court below in its majority opinion stated, without any basis in the record, that the Board of Appeals did not consider the evidence of the said affidavits. It was therefore the duty of that Court to remand the case to the Patent Office to consider the evidence.

Argument.

Fundamental equity requires that when a lower tribunal certifies a record to an appellate tribunal as including certain evidence, the appellate tribunal is not at liberty to guess or surmise as to what was not considered by the lower tribunal. The Commissioner of Patents who certified the record to the Court is the respondent here, and is bound by his own certified record (Rule 16 of this Court).

Reason D. The Court below misconstrued and misapplied the rule of law announced by this Court in United Carbon v. Binney & Smith, 317 U. S. 288; and Halliburton v. Walker et al. 329 U. S. 1.

Argument.

The Court below based its conclusions of law on the premise that the physical characteristic "electrically conductive" renders the claims indefinite, relying on the *United Carbon,* and the *Halliburton* cases *supra.* The rejected claims are not indefinite under the reasoning and decision in the *United Carbon* case because the type of claim in that

case was a *single* means claim and the patentee was endeavoring to rely on such expressions as "substantially pure", "commercially uniform", "comparatively small" which the Court found were insufficient to enable the public to determine where infringement might begin and where it might end. There is no such situation presented in petitioners' rejected claims. The record clearly shows that infringement can be avoided by using a non-conductive blank or an "ordinary carbon paper" such as taught by the reference. The claim in the *United Carbon* case used the expression "approximately one-sixteenth of an inch" but the record in that case showed that the plaintiff was endeavoring to extend that precise dimensional limitation to bring in as an infringement, dimensions of 1/4th to 1/100th of an inch. The record in this case shows beyond the peradventure of a doubt that the claims if allowed to petitioners could never be asserted as covering the blank of the reference patent. There would be an estoppel or record against petitioners. Petitioners' claims such as claims 23, 25, 26-32 do not rely on such indefinite functional expressions as in the *United Carbon* case, but on a definitely ascertainable physical characteristic namely that the *composite* dye-carbon coating is **electrically conductive**, as distinguished from **electrically insulating.**

The rejected claims are not *single* means claims, as in the *United Carbon* case, but are for a novel combination comprising three distinct structural elements, (1) pliable paper backing, (2) *composite* carbon-dye coating which is also electrically conductive, (3) a contrasting overall masking coating (R. 6, 7, 19). This combination of elements with the property of electric conductivity in the dye coating is not found in the reference which is in no way concerned with electric conductivity. The record before this Court shows beyond any doubt that the blank of the reference is

not electrically conductive. The Court below erroneously assumed, in spite of the record, that the rejected claims merely differ from the reference by the property of electric conductivity. Even if the Court's assumption had been correct, its conclusion of law that a "property" limitation is not countenanced by the prior rulings of this Court, is in itself reversible error.

In *Halliburton* v. *Walker, supra,* this Court ruled that the vice in the claims then before it was that they attempted to distinguish the most crucial element in the new combination "in terms of what it will do rather than in terms of *its own physical characteristics*" (329 U. S. 1, at 9). The limitation "electrically conducting" or "electrically conductive" is not a mere "use" limitation, but is a true physical property or characteristic limitation, which this Court inferentially, at least, has indicated is proper (see also *Holland Furniture Co.* v. *Perkins Glue Co.,* 277 U. S. 245, 256). Furthermore the *ratio decidendi* of the *Halliburton* case was, as in the *United Carbon* case, that the public could not know where infringement began and where it stopped. The petitioners would obviously be estopped by the record here to contend that their claims cover a blank which does not have a composite dye-carbon coating and which is electrically non-conducting. The public is clearly free to use the blank of the reference without infringing petitioners' claims.

The rejected claims, of which claim 25 is typical would appear to be within the purview of the type of claim that was approved by this Court in *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.,* 321 U. S. 275, and in *Faulkner* v. *Gibbs,* 338 U. S. 267.

Reason E. The single prior art reference upon which the Board and Court below relied, discloses a different combination wherein electric conductivity is of no utility, whereas the property of electric conductivity gives life and meaning to petitioners' claims.

Argument.

Petitioners' blank as covered by claims 23, 25, 26-32 is an electro-sensitive one, constructed and designed for the recording and duplicating of electric telefacsimile signals. The blank of the reference is intended for use in a typewriter or similar type-bar machine. Therefore petitioners' claims must not have their elements construed piece-meal so as to compare them if possible with elements of the reference, but should be construed as a *unitary concept* so that the entire setting of the claim language may be properly understood in the light of the problem that is solved. In such a situation the preamble to the claims cannot be ignored, particularly when the physical characteristic of electric conductivity in the composite dye-carbon coating is unavoidably tied in with the preamble to the claim. The reference completely fails as a disclosure of an electro-sensitive blank which is specially designed to record and respond to applied electric signals. The record certified to the Court below and to this Court, shows beyond any doubt, not only is the blank of the reference non-conductive, but that the physical characteristic of electric conductivity has no significance or utility therein. Neither the Board nor the Court could justifiably read into the reference a disclosure of electric conductivity not contained therein either expressly or by implication, and to do so would be against the intended mode of operation of the reference. (*Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403). In the ab-

sence of petitioners' disclosure, no one reading the reference would realize the importance of having an electrically conductive blank merely because it refers to "ordinary carbon paper." The knowledge used by the Board and the Court below to reject petitioners' claims was knowledge acquired "after the event" and after having seen petitioners' disclosure. (*Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U. S. 428, 435).

Conclusion.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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CHARLES A. MORTON,
Of Counsel.

May 25, 1951.

Appendix A.

Pertinent Statutes & Commissioner's "Notice" With Pertinent Parts Emphasized.

28 U. S. C. Sec. 1256.

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari (June 25, 1948, c. 646, Sec. 1, 62 Stat. 928).

28 U. S. C. Sec. 1542.

The Court of Customs and Patent Appeals shall have jurisdiction of appeals from decisions of:

(1) the Board of Appeals and the Board of Interference Examiners of the Patent Office as to patent applications and interferences, at the instance of an application for patent or any party to a patent interference, *and such appeal by an applicant shall waive his right to proceed under Section 63 of Title 35;* and • • • (June 25, 1948, c. 646 Sec. 1, 62 Stat. 942).

Statute before repeal or amendment	Present Statute
Sec. 4911 R. S. (35 U. S. C. Sec. 59).	Sec. 4911 R. S. (35 U. S. C. Sec. 59a).
The determination of appeals from the decision of the Commissioner of Patents is vested in the Court of Appeals of the District of Columbia; • • • (repealed Mar. 2, 1927).	If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, *in which case he waives his right to proceed under section 63 of this title* • • • (R. S. 4911) (Mar. 2, 1927, c. 273, sec. 8, 44, Stat. 1336; Mar. 2, 1929, c. 488, sec. 2, 45, Stat. 1476).

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused, either by the Commissioner of Patents or by the Court of Appeals of the District of Columbia upon appeal from the Commissioner, *the applicant may have remedy by bill in equity;* * * *

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, *unless appeal has been taken to the United States Court of Customs and Patent Appeals,* and such appeal is pending or has been decided, may have remedy by bill in equity, if filed within six months after such refusal or decision; * * * (R. S. 4915).

(Mar. 2, 1929, c. 488, sec. 2(b), 45 Stat. 1476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212).

Act of March 2, 1929 (Public No. 914, 70th Congress)

Sec. 2(a). The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals (Mar. 2, 1929, c. 488, Sec. 1, 45 Stat. 1475).

Sec. 4912 R. S. (35 U. S. C. Sec. 60).

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

Sec. 4914 R. S. (35 U. S. C. Sec. 62).

The court, on petition, *shall hear and determine such appeal,* and revise the decision appealed from in a summary way, *on the evidence produced before the commissioner* at such early and convenient time as the court may

appoint and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, *and shall govern the further proceedings in the case.* But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Sec. 4913 R. S. (35 U. S. C. Sec. 61).

The court shall, before hearing such appeal give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give notice of such time and place, in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies *of all the original papers and evidence in the case,* and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing touching all the points involved by the reasons of appeal.

Commissioner of Patents Notice of January 4, 1950 (Vol. 630 O. G. No. 3 p. 617).

1. *Purpose of Notice.* This notice sets forth the present position of the Office concerning the status of an application following ex parte appeal to the Court of Customs and Patent Appeals. Any prior decisions or instructions of the Commissioner inconsistent with this Notice are overruled from the date hereof.

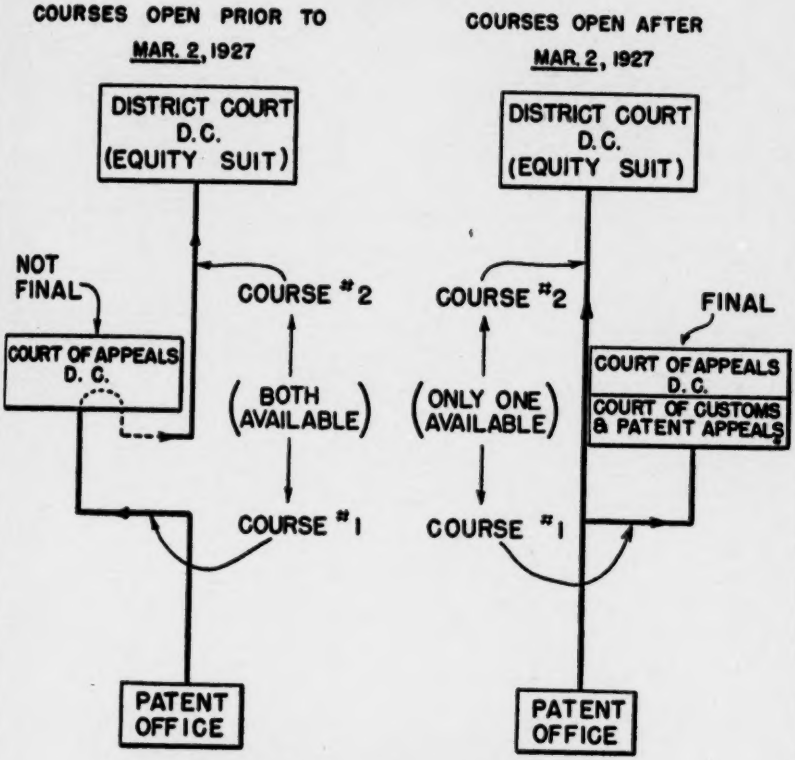
2. *Certificate of the Court.* After hearing the case the court returns to the Office "a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case" (R. S. 4914; 35 U. S. C. 62). The receipt of this certificate by the Office marks the conclusion of the appeal.

3. *All claims rejected.* If all claims in the case stand rejected, proceedings on the application are considered terminated on the date of receipt of the Court's certificate and the application is not open to subsequent amendment and prosecution by the applicant. The application is no longer considered pending.

4. *Some claims allowed.* If some claims in the case stand allowed, either by reversal of the Office decision by the Court or by having been allowed by the Examiner or the Board of Appeals, proceedings are considered terminated as to the rejected claims. Action by the applicant canceling the rejected claims is not considered necessary. The Examiner will pass the case for issue forthwith on the allowed claims, the applicant being advised of such action. The rejected claims may be canceled by the Examiner with an appropriate notice on the margin, to avoid confusion of the printer. However, if formal matters remain to be attended to, the Examiner should take appropriate action on such matters, setting a shortened period for reply, but the application is considered closed to further prosecution except as to such matters.

APPENDIX "B"

POSTUM V. CALIFORNIA FIGNUT (272 U.S. 693)
DECIDED
JAN 3, 1927



*JURISDICTION OF COURT OF APPEALS D.C. IN PATENT OFFICE APPEALS TRANSFERRED TO COURT OF CUSTOMS AND PATENT APPEALS MAR. 2, 1929

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In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 87

HAROLD R. DALTON AND AUSTIN G. COOLEY,
PETITIONERS

v.

JOHN A. MARZALL, AS COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinions of the Court of Customs and Patent Appeals (R. 90-100) are reported at 188 F. 2d 170.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was entered on March 6, 1951 (R. 100-101). A petition for rehearing was denied on April 10, 1951 (R. 122). The petition for a writ

of certiorari was filed on May 31, 1951. Petitioners invoke the jurisdiction of this Court under 28 U.S.C. 1256. If this Court has any jurisdiction at all to review decisions rendered by the Court of Customs and Patent Appeals on patent matters under R. S. 4914 (35 U.S.C. 62), it may be assumed that the petition was filed in time.

QUESTION PRESENTED

Whether this Court has jurisdiction to issue a writ of certiorari to review a decision of the Court of Customs and Patent Appeals affirming a determination by the Board of Appeals of the Patent Office declining to allow certain claims in an application for a patent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra*, pp. 11-14.

STATEMENT

Petitioners, claiming to be the original and first inventors of certain new and useful improvements in "Telefacsimile Recording and Duplicating Paper," filed an application with the United States Patent Office for a patent on the claimed invention (R. 3-17). Claims 21, 23 to 36, inclusive, and 39, included in petitioners' application, were finally denied by the Board of Appeals of the United States Patent Office, as lacking invention, and Claims 12, 13, 15, 16, and 18 were rejected "as not

readable on the elected species" (R. 45, 46). On appeal to the United States Court of Customs and Patent Appeals, the decision of the Board of Appeals was affirmed (R. 90-98, 100-101).

ARGUMENT

We submit that the decision of the court below is correct in every respect for the reasons set forth in the majority opinion and would not in any event warrant review. Moreover, the decisions of this Court show that this Court lacks both constitutional and statutory authority to review this class of case.

This Court has long held that it has no constitutional power to review lower court decisions rendered in summary appeals authorized by R.S. 4914, *infra,* pp. 11-12, to be taken from determinations made by the Patent Office in connection with applications for the grant of patents or the registration of trademarks.[1] In the case of *Postum Cereal Com-*

[1] The history of the summary appeal authorized by R. S. 4914, *infra,* pp. 11-12, is briefly, as follows:

Prior to 1893, authority to hear summary appeals from decisions of the Commissioner of Patents in patent matters was vested in the Supreme Court of the District of Columbia, sitting en banc. See R. S. 4911-4912. By the Act of February 9, 1893, 27 Stat. 434, 436, Congress created the Court of Appeals of the District of Columbia and transferred to that court the authority formerly vested in the Supreme Court of the District of Columbia to hear summary appeals taken from decisions of the Commissioner of Patents in patent matters. By Section 9 of the Act of February 20, 1905, 33 Stat. 724, 727, Congress vested the Court of Appeals of the District of Columbia with jurisdiction to hear summary appeals from decisions of the Commissioner of Patents in trademark matters, and provided that the practice and procedure applicable to sum-

pany v. *California Fig Nut Company,* 272 U.S. 693, a trademark case, this Court in a comprehensive opinion held that a decision of the Court of Appeals of the District of Columbia in such an appeal proceeding was "not a judicial judgment," but was "merely an instruction * * * by a court which is

---

mary patent appeals should govern the summary trademark appeals. At all times, R. S. 4914 has provided, and still provides that the decision of the court in a summary appeal shall not preclude any person interested from the right to contest the validity of the patent involved in the appeal in any court wherein the same may be called in question. This provision applies as well to trademark registration summary appeals. By the Act of March 2, 1929, c. 488, 45 Stat. 1475-1476, *infra*, p. 11, Congress changed the name of the Court of Customs Appeals to the Court of Customs and Patent Appeals and transferred to that court from the Court of Appeals of the District of Columbia authority to hear summary appeals from Patent Office determinations in both patent and trademark matters.

Until 1927, R. S. 4915 provided that if a patent should be refused by either the Commissioner of Patents or the Court of Appeals of the District of Columbia, the applicant might have a remedy by bill in equity filed in the Supreme Court of the District of Columbia (now the United States District Court for the District of Columbia), which court might adjudge that the applicant was entitled to the patent. In *American Foundries* v. *Robertson*, 262 U. S. 209, this Court held that R. S. 4915 was applicable to trademark registrations as well as to patent applications. Thus, as the law then stood, an applicant had a right to both the summary appeal and the remedy by bill in equity. By the Act of March 2, 1927, c. 273, 44 Stat. 1335, 1336-1337, Congress amended R. S. 4911 and 4915 to provide that an applicant to whom a patent should be refused might proceed either by summary appeal or by bill in equity, but if he should proceed by way of summary appeal he would waive his right to proceed by way of a bill in equity. As thus amended, R. S. 4911 and 4915, *infra*, pp. 12-14, now give an applicant who has been refused a patent an election to proceed either by summary appeal or by bill in equity, but he may no longer have the benefit of both remedies. See 35 U.S.C. 59a and 63. See also the Act of July 5, 1946, 60 Stat. 435; 15 U.S.C. 1071, which expressly gives an applicant for a trademark registration the same election of remedies.

made part of the machinery of the Patent Office for administrative purposes" (pp. 698-699). Consequently, such a proceeding was considered not to be a case or controversy, in the constitutional sense, which this Court was authorized to review. See also *Pacific Northwest Canning Company* v. *Skookum Packers' Ass'n,* 283 U. S. 858 (a trademark case), and *McBride* v. *Teeple,* 311 U.S. 649 (a patent case), wherein this Court, citing the *Postum Cereal Company* case, held that it had no jurisdiction to review summary appeals taken from Patent Office determinations in patent and trademark matters. This Court has also, without comment as to jurisdiction, declined to review a long list of other decisions in summary appeals taken from determinations of the Patent Office in patent and trademark matters. See *Panhard Oil Corp.* v. *Societe Anonyme,* 282 U. S. 858; *I. G. Farbenindustrie* v. *Lacy,* 282 U.S. 870; *Fessenden* v. *Wilson,* 284 U.S. 640; *Laughlin* v. *Robertson,* 284 U.S. 652; *United States Gypsum Co.* v. *Plastoid Products, Inc.,* 284 U.S. 635; *Keller, Heumann & Thompson Co., Inc.* v. *Coe,* 298 U.S. 656; *Chase* v. *Avery,* 307 U.S. 638; *Galena Manufacturing Co.* v. *Superior Oil Works,* 308 U.S. 609; and *A. J. McPartland, Inc.* v. *Montgomery Ward & Co., Inc.,* 333 U.S. 875.

In the earlier cases of *Frasch* v. *Moore,* 211 U.S. 1 (a patent case), *Atkins & Company* v. *Moore,* 212 U.S. 285 (a trademark case), *Gaines* v. *Knecht,* 212 U.S. 561-562 (a trademark case), and *Baldwin*

Company v. *Howard Company,* 256 U.S. 35 (a trademark case), this Court had declined to review summary appeal decisions on the ground that such decisions were not final judgments within the meaning of Section 8 of the Act of February 9, 1893, 27 Stat. 434, 436, which authorized it generally to review "final judgments" of the Court of Appeals of the District of Columbia.[2] In the *Postum Cereal Company* case, this Court agreed that the decisions in those cases were not final judgments, but pointed out (page 699) that that fact "should not be understood to imply that, in such a proceeding, circumstances might give it a form that would make it a final judgment subject to review by this Court." Thus, this Court made it clear that its decision in the *Postum Cereal* case was not based upon lack of finality in the decision of the appellate court but upon the nature of the proceeding. And the fact that when that case was decided an applicant might bring a bill in equity even after pursuing his appellate remedy, whereas since the passage of the Act of March 2, 1927, 44 Stat. 1335, 1336, the appellate and bill-in-equity remedies are mutually exclusive, would not appear to be significant with respect to the constitutional authority of this Court to review

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[2] In the case of *Estate of P. D. Beckwith, Inc.* v. *Commissioner of Patents,* 252 U.S. 538, the Court granted a writ of certiorari and reviewed the summary appeal decision in a trademark case. In that case, however, the jurisdictional question was not raised, and in *Baldwin Company* v. *Howard Com-*

summary appeal decisions in patent or trademark matters. This, we believe, is confirmed by the fact that after the two remedies were made mutually exclusive this Court, in denying the writs for want of jurisdiction in *Pacific Northwest Canning Co.* v. *Skookum Packers' Ass'n,* 283 U.S. 858, and *McBride* v. *Teeple,* 311 U.S. 649, relied expressly upon its prior holding in the *Postum Cereal Company* case.

Petitioners invoke 28 U.S.C. 1256 to sustain the jurisdiction of this Court to grant the writ of certiorari and review the decision of the court below.[3] Petitioners' reliance on that section overlooks the holding of this Court in the *Postum Cereal Company* case, *supra,* that it has no constitutional power to review decisions in summary appeals taken from determinations of the Patent Office in patent and trademark matters, since such proceedings and the review thereof are administrative, not judicial in nature. Thus, whether or not the language of 28 U.S.C. 1256 may be considered as being broad enough to include all cases in the Court of Customs and Patent Appeals, the section is not effective to authorize this Court to review summary appeals of this character, since such proceedings are not cases or controversies

pany, 256 U.S. 35, this Court characterized its grant of the writ of certiorari in the *Beckwith* case as being inadvertent and not establishing jurisdiction.

[3] Sec. 1256: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

in the constitutional sense. At the time the *Postum Cereal Company* case was decided, this Court was authorized by Section 240(a) of the Judicial Code, as amended by the Judiciary Act of 1925, 43 Stat. 936, 938-939 (see 28 U.S.C. (1946 ed.) 347, now 28 U.S.C. 1254), to review "any case" in the Court of Appeals of the District of Columbia, but the mere fact that the language of the authorizing statute was broad enough to include all cases which the court of appeals was authorized to hear and determine could not make the statute operate to vest this Court with jurisdiction over a proceeding not included in the constitutional grant of judicial power.

Furthermore, we believe it highly unlikely that Congress, when it passed the Act of June 25, 1948, 62 Stat. 869, codifying into law Title 28 of the United States Code, intended that the new Section 1256 of that Title should have the effect of enlarging this Court's jurisdiction to review decisions of the Court of Customs and Patent Appeals rendered in summary appeals in patent and trademark matters. Prior to the effective date of the 1948 Act, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was Section 195 of the Judicial Code, as amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308. That section, which empowered

the Court of Customs and Patent Appeals to hear appeals from the Customs Court and authorized this Court to review the decisions of the Court of Customs and Patent Appeals in such cases, related only to customs cases. It did not refer to either patent or trademark matters. In the codifying act, Congress merely separated the two provisions, placing in 28 U.S.C. 1541 the authority of the Court of Customs and Patent Appeals to hear appeals in customs cases, and in Section 1256 the authority of this Court to review by writ of certiorari cases in the Court of Customs and Patent Appeals. We have found nothing in the codifying act or its history to indicate that there was a conscious effort on the part of Congress to give this Court authority to review a class of cases over which its jurisdiction had previously been withheld. And there would seem to be no plausible reason to impute to that body an intention to do so, especially since the classes of proceedings over which jurisdiction was previously withheld were the same as those which this Court in the *Postum Cereal Company* case had held it was without constitutional power to review.

The Commissioner of Patents desires it to be stated that his office has no special interest in either sustaining or contesting the jurisdiction of this Court to review summary appeal decisions of the Court of Customs and Patent Appeals in patent or trademark matters. He suggests, how-

ever, that it would be helpful if this Court, in disposing of the instant case, would indicate whether or not it has jurisdiction to review decisions of the Court of Customs and Patent Appeals in such cases.

It is respectfully submitted that the petition for a writ of certiorari should be denied for want of jurisdiction as in *McBride* v. *Teeple,* 311 U.S. 649.

PHILIP B. PERLMAN,
Solicitor General.

JOHN R. BENNEY,
Attorney.

E. L. REYNOLDS,
Solicitor for the Patent Office.

JULY, 1951.

APPENDIX

Act of March 2, 1929, c. 488, 45 Stat. 1475-1476:

> That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.
>
> Sec. 2(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

28 U. S. C. 1256:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

Section 4914 of the Revised Statutes, 35 U. S. C. 62:

> The court [Court of Customs and Patent Appeals], on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no

opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Sections 4911 and 4915, R. S., as amended, 27 Stat. 436, 44 Stat. 1335, 1336; 45 Stat. 1476; 53 Stat. 1212; 35 U. S. C. 59a, 63:

Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Sec. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the

further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 87.

IN THE MATTER

of

The Application of HAROLD R. DALTON and AUSTIN G. COOLEY for United States Letters Patent.

HAROLD R. DALTON and AUSTIN G. COOLEY,
Petitioners,

vs.

JOHN A. MARZALL as Commissioner of Patents,
Respondent.

PETITIONERS' REPLY BRIEF.

JOHN J. ROGAN,
Counsel for Petitioners.

CHARLES A. MORTON,
Of Counsel.

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HAROLD R. DALTON and AUSTIN G. COOLEY,
Petitioners,

vs.

JOHN A. MARZALL as Commissioner of Patents,
Respondent.

PETITIONERS' REPLY BRIEF.

Under the heading "Question Presented" the Respondent limits his opposition to the petition, solely to the jurisdiction of this Court. The questions raised by the petition are predicated on a denial of due process in the Court below, by reason of that Court's unwarranted construction of the statute (Sec. 4914 R. S.), and by reason of its refusal to consider vital and necessary evidence which was certified to it. (See Questions 1 and 2, page 2 of petition.)

As stated by Mr. Justice Frankfurter in 47 Columbia Law Review, page 527 (1947), "It is certainly true of the

Supreme Court that almost every case has a statute at its heart or close to it." The Court below has given what is believed to be an unjustifiably limited meaning to the statute (Sec. 4914 R. S.) and in doing so has deprived the petitioners of their right under the Constitution of the United States, to a proper judicial review. That in itself would justify this Court in granting the petition. It is essential to due process that a reviewing Court such as the Court of Customs and Patent Appeals, consider all the evidence which is *necessary* to a proper determination. The Court below refused to consider the evidence *which goes to the heart of the matter,* namely whether the single prior art reference (R. 73-77) relied upon by the Commissioner, teaches an *electro-sensitive* recording and duplicating telefacsimile blank wherein one of the elements is purposely prepared so as to be an *electrical conductor.* Certainly the statute and fundamental law require the Court below to consider all the *necessary* evidence certified to it and without which it could not arrive at a proper judicial determination.

The Respondent's Argument.

The respondent grounds his argument primarily on *Postum Cereal* v. *California Fig Nut,* 272 U. S. 693 upon which *McBride* v. *Teeple,* 311 U. S. 649 is also based. However, respondent fails to note the clear legal distinction between the refusal of the Commissioner of Patents to entertain an opposition to the mere *registration* of a trade-mark, and the Commissioner's final refusal of patent claims. It is fundamental trade-mark law that a property right in a trade-mark is acquired by mere prior adoption and use. That requires no administrative action by the Commissioner to vest the property right. In the *Postum Cereal* case, the Court could not have settled the common-law prop-

erty right in the trade-mark in such a *registration* proceeding. On the other hand, by final refusal of petitioners' patent claims, the petitioners are forever barred from obtaining their constitutional property rights therein. The "right to contest the validity" which was one of the reasons given by this Court as a ground for lack of jurisdiction in the *Postum Cereal* case, can never arise in petitioners' case until a patent is actually granted to petitioners. Whether or not the patent can be contested in a subsequent infringement action is irrelevant and immaterial. If such kind of contestability were a sound basis for refusing to entertain the petition, it would apply equally well to an appeal to this Court under Sec. 4915 R. S. Obviously therefore this "contestability" test is irrelevant, where the action of the Commissioner is a final adjudication on petitioners' right to certain patent claims. With all due respect to the prior decision in the *Postum Cereal* case, it is believed that the reasoning applying to a mere trade-mark registration, does not apply to a final rejection of a patent claim.

The Cases Cited by the Respondent.

Of the cases cited in pages 5 and 6 of the respondent's brief, some were trade-mark proceedings, and some were patent proceedings. However, all the cases were decided before the enactment of the statute (28 U. S. C. 1256), on June 25, 1948. Of the cases involving patent proceedings, none according to the published decisions raised the constitutional issue of the deprivation of property rights or denial of due process of law by reason of an unwarrantedly limited construction by the Court below of Sec. 4914 R. S., and the refusal of that Court to consider *necessary* evidence *certified to it by the Commissioner*. Nor did they

apparently appreciate the difference in the way a final rejection of patent claims judicially cuts off further determination of property rights therein, as compared with a trade-mark registration proceeding where the property right arises entirely by adoption and use and no cut off of property right ensues.

In summarizing the cited cases, the respondent states "Thus, this Court made it clear that the decision in the *Postum Cereal* case was not based upon lack of finality in the decision of the appellate court but upon the nature of the proceeding." However, it is a fact that the Court of Customs and Patent Appeals does not merely act as an "administrative body". In arriving at a judicial determination, it applies and interprets the decisions of this Court. One of the issues raised by the petition is whether the Court of Customs and Patent Appeals can constitutionally refuse to consider *necessary* and vital evidence *certified to it by the Commissioner,* and whether its interpretations of the prior rulings of this Court are correct. The dissenting opinion of Mr. Justice O'Connell (R. 98-100) shows that the Court below is divided in its construction of the statute.

With respect to respondent's comments on 28 U. S. C., Sec. 1256 and the *Postum Cereal* case, here again it would appear respondent fails to make a distinction between the naked right to review any and all decisions of the Court below, with the power of this Court to protect the constitutional rights of petitioners, against erroneous construction of a Federal Statute, and erroneous interpretations of prior decisions of this Court. The instant proceeding became a "controversy" when the Court below refused to consider *necessary and vital* evidence certified to it, and as to which refusal, petitioners could have had no notice *until the Court below had rendered a decision.* The petition for rehearing clearly raised a controversy and an issue within the consti-

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tutional sense (*Brinkerhoff-Faris Trust* v. *Hill*, 281 U. S. 673; *Saunders* v. *Shaw*, 244 U. S. 317, 320). The Commissioner treated the proceeding below as a case since he appeared by counsel in opposition, and the statute Sec. 4914 R. S. gives the Court below the power of "hearing the *case.*"

The respondent argues that "it is highly unlikely" that Congress intended to enlarge this Court's jurisdiction when it codified the law (Act of June 25, 1948, 62 Stat. 869). The history of the Act does not support respondent's contention. Congress for many years had been studying the effects of decisions of Administrative Agencies, and in order fully to protect the constitutional rights of parties appearing before such Agencies, it enacted the "Administrative Procedure Act of 1946" (Title 5 U. S. C. Secs. 1001 *et seq;* 60 Stat. 237) which gave such parties the "right to judicial review thereof" to redress a "legal wrong" resulting from any Agency action. While the Court of Customs and Patent Appeals may be excluded from the definition of "Agency", presumably if it is merely an "administrative arm" of the Patent Office, it is entirely illogical to assume that Congress in enacting the Act of June 25, 1948 did not intend to give parties the right to redress legal wrongs arising in such an alleged "administrative arm" of the Patent Office. Prior to the codification of June 25, 1948, Congress made a clear reference to the right to petition in Customs cases alone, and expressly included that right even though as a matter of fact even in Customs cases the issue might have been merely an administrative one. If Congress did not intend to enlarge the jurisdiction on petitions it could have *left the statute the way it originally stood.* Instead of doing that, Congress expressly passed the Act extending the jurisdiction without making any distinction between Customs cases and Patent cases in the Court below. The Act

is clear and unambiguous. The respondent is the one raising doubts as to the intentions of Congress, and this he cannot properly do (*Hamilton* v. *Rathbone,* 175 U. S. 414 and cases therein cited). This Court on many occasions has ruled that while a prior Act of Congress can be resorted to, to resolve an ambiguity, it cannot be resorted to, to *create* an ambiguity.

Conclusions.

1. The respondent's brief is grounded on the reasoning in the *Postum Cereal* case, which however must be read in the light of this Court's subsequent decisions (see pages 8 and 9 of petition).

2. Respondent entirely ignores the constitutional issue of deprivation of a property right without due process, arising from the lower Court's unwarranted construction of Sec. 4914 R. S., and its unwarranted interpretation of the prior decisions of this Court (see pages 12-16 of petition).

3. Respondent is "creating" an ambiguity in an otherwise unambiguous Federal Statute (28 U. S. C. 1256).

Respectfully submitted,

JOHN J. ROGAN,
Counsel for Petitioners.

CHARLES A. MORTON,
Of Counsel.

July 17, 1951.